In response, applicants hereby elect Group II, claims 19, 27-28 and 30, drawn to a method of treating androgen-independent prostate cancer comprising administering an anti-Her-2/neu antibody and a chemotherapeutic agent, with traverse for prosecution at this time.

The Examiner also stated that Groups I and II are further subject to election of a single disclosed invention. The Examiner asserted that claims 19 and 27 are generic to a plurality of disclosed patentably distinct species comprising treatment with chemotherapeutics with different structures and functions, namely the ten chemotherapeutic agents claimed in claim 28.

In response, applicants hereby elect the species of paclitaxel in the event no generic claim is finally deemed allowable.

Remarks

Applicants, however, respectfully request that the Examiner reconsider and withdraw the restriction requirement. Under 35 U.S.C. §121, restriction may be required if two or more independent and distinct inventions are claimed in one application. Under M.P.E.P. §803, the Examiner must examine the application on the merits, even though it includes claims to distinct inventions, if the search and examination can be made without serious burden.

The inventions of Groups I and II are not independent. Under M.P.E.P. §802.01, "independent" means there is no disclosed relationship between the subject matter claimed. The inventions of Groups I and II are drawn to methods related to the diagnosis

and treatment of prostate cancer using various cancer-associated proteins. Applicants therefore maintain that Groups I and II are not independent and restriction is not proper.

Furthermore, under M.P.E.P. §803, the Examiner must examine the application on the merits if examination can be made without serious burden, even if the application would include claims to distinct or independent inventions. That is, there are two criteria for a proper requirement for restriction: (1) the invention must be independent and distinct, and (2) there must be a serious burden on the Examiner if restriction is not required.

Applicants respectfully submit that there would not be a serious burden on the Examiner if restriction were not required, because a search of the prior art relevant to the claims of Group I would not require a serious burden once the prior art relevant to Group II has been identified.

Therefore, there would be no serious burden on the Examiner to examine Groups I and II together in the subject application. Hence, the Examiner must examine these Groups on the merits.

In view of the foregoing, applicants maintain that restriction is not proper under 35 U.S.C. §121 and respectfully request that the Examiner reconsider and withdraw the requirement for restriction.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorneys invite the Examiner to telephone them at the number provided below.

No fee is deemed necessary in connection with the filing of this Communication. However, if any fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

8/4/04

Alan J. Morrison Date
Reg. No. 37,399